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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,989	12/06/2000	Kentaro Nakada	HIG05 001	7372
7590	01/15/2004		EXAMINER	
DUANE MORRIS LLP 1667 K STREET, N.W. SUITE 700 WASHINGTON, DC 20006			NATNAEL, PAULOS M	
			ART UNIT	PAPER NUMBER
			2614	
			DATE MAILED: 01/15/2004	
			7	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/729,989	NAKADA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Paulos M. Natnael	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 October 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinsel, U.S. Pat. No. 5,325,127 in view of Shimakawa et al, U.S. Pat. No. 6,452,644.

Considering Claim 1, Shimakawa disclose the following claimed subject matter, note;

a) the claimed broadcasting a reception screen *broadcasting* and a program for controlling the sound suited to this screen to a receiver by using data broadcasting band in television broadcasting, and also *broadcasting images of one channel of program and broadcast contents of plural programs used in data broadcast in the sound broadcasting band usually in combination to the receiver, and, at the receiver, selecting one desired program from the combined image and sound mixed signals of plural programs by the program already received, and displaying on the screen of the receiver and delivering the sound of this screen is met by Fig. 3, which is a receiver for receiving a data broadcast in the TV data multibroadcast sound subcarrier system.*

*Except for;*

*b) the claimed broadcasting* and a program for controlling the sound suited to this screen;

Regarding b), Shimakawa et al. disclose a method of controlling reception in data broadcast receiver. Shimakawa et al. disclose transmitting electronic program guide (EPG) and other programs. Shimakawa et al. do not specifically disclose "controlling the sound suited to this screen". However, Shimakawa disclose "A TV data broadcast system... The system allows data reception by mobile receivers and uses data signal subcarriers 4.5 fH and 7.5 fH (fH=15.73 kHz, the horizontal synchronizing pulse frequency) within a sound signal band of a television signal as the transmission path. The terrestrial data broadcast system provides programs such as: Electronic mail service; News, such as, newspapers, magazines, TV programs and others... (col. 1, lines 14-24)

Furthermore, Shimakawa et al. disclose that "reception control information is broadcast which specifies the broadcasting time of specific programs" (col. 3, lines 26-27) and "It should further be noted that **the reception control information data itself maybe specified as a program**, the program number identifying the reception control information broadcast." (col. 5, lines 8-13) [emphasis added]

Therefore, it would have been obvious to the skilled in the art at the time the invention was made to modify the system of Shimakawa by adding a control information program specifically geared towards the sound or audio for the screen, in order to easily and unambiguously control the sound information in the screen and information data that has been transmitted along with the broadcast television signal.

Considering claim 2, in a broadcasting system for television broadcasting, a method comprising the steps of: at the transmitter, broadcasting a reception screen and a program for controlling the sound suited to this screen to a receiver by using data broadcasting band; *broadcasting images of one channel of program and broadcast contents of plural programs in the sound broadcasting band;* at the receiver, selecting a desired program from the broadcast contents sent in the sound broadcasting band using the received program, and displaying on the screen and providing sound to the reception screen.

Claim 2 is a method of claim 1 and thus claim 2 is rejected for the same reasons as in claim 1;

Considering claim 3, wherein the broadcast contents of plural programs contain video signals and audio signals, is met by the television signal receiver in Fig.5 which includes video decoder to decodes video/image signal and by the well-known fact that TV broadcast receivers, by definition, comprising video as well as audio signals.

Considering claim 4, wherein the audio signals are separated and reproduced using the received program;

Regarding claim 4, Shimakawa discloses that the reception control information data itself may be specified as a program, (as mentioned above in connection to rejection of claim 1), the program number identifying the reception control information. Therefore, it would have been obvious to the skilled in the art at the time the invention

was made to modify the system of Shimakawa by specifying the control information data to control the separation and reproduction of the audio signals, so that the user can reproduce the sound or audio as desired.

Considering claim 5, wherein the broadcast contents include program titles, is met by the television receiver in Fig.5 arranged to receive Electronic Program Guide (EPG) data, which data includes program titles and other information of the desired program.

### ***Response to Arguments***

3. Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive. Response follows:

#### Applicant's Argument

Applicant argues that there is not disclosure or teaching to control the selection of sound from sound mixed signals by a program received over the broadcast band. And Shimakawa does not disclose, teach or suggest "selecting one desired program from the combined image and sound mixed signals of plural programs by the program already received".

#### Examiner's Response

Shimakawa et al. disclose a method of controlling reception in data broadcast receiver, and teach/disclose transmitting electronic program guide (EPG) and other programs.

Shimakawa disclose that in a TV data broadcast system... "The system allows data reception by mobile receivers and uses data signal sub-carriers 4.5 fH and 7.5 fH (fH=15.73 kHz, the horizontal synchronizing pulse frequency) within a sound signal band of a television signal as the transmission path. The terrestrial data broadcast system provides programs such as: Electronic mail service; News, such as, newspapers, magazines, TV programs and others... (col. 1, lines 14-24) Furthermore, Shimakawa et al. disclose that "reception control information is broadcast which specifies the broadcasting time of specific programs" (col. 3, lines 26-27) and that "It should further be noted that the reception control information data itself maybe specified as a program, the program number identifying the reception control information broadcast." [Emphasis added] (col. 5, lines 8-13) The Shimakawa reference discloses a "TV data multibroadcast sound subcarrier system". (col. 1, lines 14-43, and col. 3, lines 55-67) The system certainly has the capability to select one desired program from the combined image and sound mixed signals of plural programs by the program already received among the received data in multibroadcast sound system. Therefore, the argument that there is no teaching of "selecting one desired program from the combined image and sound mixed signals of plural programs by the program already received" is unpersuasive.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

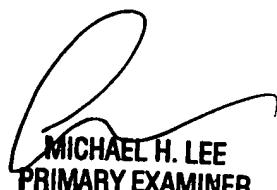
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (703) 305-0019. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-HELP.

Paulos Natnael  
January 11, 2004



MICHAEL H. LEE  
PRIMARY EXAMINER